

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

LAWMAN ARMOR CORPORATION,

Plaintiff,

v.

WINNER INTERNATIONAL, LLC,

Defendant.

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CIVIL ACTION NO. 02-CV-4595

Hon. Robert F. Kelly

**ORDER**

AND NOW, this \_\_\_\_ day of \_\_\_\_\_, 2002, upon consideration  
of the Motion of Plaintiff Lawman Armor Corp. For Leave to File a Sur-Reply Opposing  
Defendant's Motion to Dismiss, it is hereby ORDERED that Plaintiff's motion is GRANTED.

BY THE COURT:

\_\_\_\_\_  
KELLY, J.

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

LAWMAN ARMOR CORPORATION,

Plaintiff,

**v.**

WINNER INTERNATIONAL, LLC,

Defendant.

CIVIL ACTION NO. 02-CV-4595

Hon. Robert F. Kelly

**PLAINTIFF LAWMAN ARMOR CORP.'S MOTION FOR LEAVE TO FILE SUR-  
REPLY OPPOSING DEFENDANT'S MOTION TO DISMISS**

Plaintiff Lawman Armor Corp., by its undersigned attorneys, hereby moves this Court for leave to file a Sur-Reply Opposing Defendant's Motion To Dismiss. A copy of Lawman Armor Corp.'s proposed Sur-Reply is attached.

Respectfully submitted,

Corey Fild

Roberta Jacobs-Meadway  
Lynn E. Rzonca  
Corey Field  
BALLARD SPAHR ANDREWS & INGERSOLL, LLP  
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(215) 665-8500

Attorneys for Plaintiff  
Lawman Armor Corporation

Date: September 26, 2002

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

**LAWMAN ARMOR CORP.,**

**Plaintiff,**

**V.**

**WINNER INTERNATIONAL, LLC,**

**Defendant.**

**Civil Action No. 02-4595**

**Hon. Robert F. Kelly**

## ORDER

AND NOW, this \_\_\_\_\_ day of \_\_\_\_\_, 2002, it is hereby

ORDERED that Defendant's Motion to Dismiss for Lack of Subject Matter Jurisdiction or,

Alternatively, For Failure to Join an Indispensable Party is DENIED.

BY THE COURT:

KELLY, J.

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

<b>LAWMAN ARMOR CORP.,</b>	)	
	)	
<b>Plaintiff,</b>	)	<b>Civil Action No. 02-4595</b>
	)	<b>Hon. Robert F. Kelly</b>
<b>v.</b>	)	
	)	
<b>WINNER INTERNATIONAL, LLC,</b>	)	
	)	
<b>Defendant.</b>	)	

**Plaintiff Lawman Armor Corp.'s Sur-Reply  
Opposing Defendant's Motion to Dismiss**

Defendant's Reply simply repeats the "Missing Link" claim—a claim Plaintiff has already debunked. The Reply also raises red herrings about the date that the Keen to Yang Assignment was signed, and about a closed Florida case. It does not counter the facts and law establishing:

1. The chain of title to the '621 Patent is unbroken, and Mr. Vito today holds valid title;
2. Patent transfers do not have to be recorded with the Patent and Trademark Office, and the failure to record the Keen to Yang Assignment has no bearing on Plaintiff's standing in this case; and
3. Mr. Vito transferred all of his substantial rights in the '621 Patent to Plaintiff, Plaintiff has full standing to sue on the patent.

Defendant still has not established any grounds for its Motion to Dismiss. Plaintiff asks the Court to deny the Motion.

**I. The Keen to Yang Assignment Was Signed in 2000—  
Two Years Before this Suit was Filed**

In its Opposition to Defendant's Motion, Plaintiff established that the chain of title to the '621 Patent is unbroken, and that patent transfers do not have to be recorded with the Patent and Trademark Office in order to be valid. Defendant's only response is a weak attempt to paint the

Keen to Yang Assignment as having been signed after this case was filed. Defendant fails, because that Assignment was signed *two years before* this case was filed.

Mr. Yang's Declaration—Exhibit A to Plaintiff's Opposition—states clearly that he, on behalf of his company Keen Tools, signed the Keen to Yang Assignment on or about the Assignment's effective date of May 5, 2000. That is more than 2 years before this suit was filed.

Defendant attempts to read ambiguity into the Yang Declaration. There is no ambiguity. However, solely to preclude Defendant from making further frivolous such arguments, Plaintiff submits herewith as Exhibit A Mr. Yang's Supplemental Declaration, attesting to the fact that Keen Tools executed the Assignment on May 5, 2000.<sup>1</sup> Thus it is further established that the Keen to Yang Assignment was signed and in existence long before this suit was filed.<sup>2</sup>

Thus, this is not a case of an assignment executed after suit is filed in an attempt to create "retroactive standing," as was done in the Gaia case on which Defendant hinges its motion. Gaia involved a *nunc pro tunc* assignment executed after the plaintiff filed suit. Gaia Tech., Inc. v. Reconversion Tech., Inc., 93 F.3d 774, 779 (Fed. Cir. 1996). That is not the situation here. The plaintiff in Gaia also admitted that the assignment was memorialized in a writing after the filing of the complaint in that case. Id. That also is not the situation here. In this case, the Assignment was memorialized *before* suit was filed—2 years before. Mr. Yang's Declarations establish that

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<sup>1</sup> Mr. Yang also explains that the reference in the later June 4, 2002 Assignment to "uncertainty" about his right was included out of an abundance of caution and not because of any specific uncertainty about whether he or his company owned the patent. See Yang Supplemental Decl., Ex. A at ¶ 6.

<sup>2</sup> Defendant says that the U.S. Patent Office records show an execution date of September 11, 2002. That is an error on the part of the Office. September 11, 2002 is the date of a fax line on the Assignment. Of course, the Patent Office's administrative abstract of title does not conclusively establish a document execution date—especially where, as here, the actual signatory has attested to the execution date.

the Keen to Yang Assignment was memorialized and signed more than 2 years before the Complaint was filed. Gaia does not apply to this case.

Plaintiff has established that the chain of title to the '621 Patent is unbroken. Mr. Vito now owns the '621 Patent. As of July 11, 2002, when this case was filed, Mr. Vito owned the '621 Patent and had licensed all of his substantive rights to Plaintiff. This Court's jurisdiction is established, as is Plaintiff's right to bring this case and to enforce the '621 Patent in its own name.

## **II. The Keen Tools Florida Litigation Is Closed. The Time for Reopening That Case Expired 9 Months Ago.**

Plaintiff established in its Opposition why the closed Keen Tools Florida litigation has no bearing on this case and does not affect Plaintiff's standing. In response, Defendant tries a new tact: in an effort to circumvent this Court's jurisdiction over this case, Defendant says it will attempt to re-open the long-closed Florida case. Such attempt would be pointless—and time-barred.

The Florida suit was filed in 1999 by Keen Tools against Winner International, Inc. and Winner International Royalty Corporation in the Southern District of Florida. That litigation between those parties was closed with no findings in August 1999. (See Exhibit D to Plaintiff's Opposition, docket printout from the U.S. Courts' PACER system with entry showing case closed on 8/6/99.) The Order closing the case provides for a short window in which the case could be reopened. The window passed. The case was not reopened. It remains closed, and it cannot now be reopened.

Despite this clear record, Defendant makes the unsupported and outlandish assertion that reopening that three-year-old case is "necessary," and that the court in the Florida Case "never relinquished jurisdiction."

Defendant is wrong. It neglects to address the true contents of the Florida court's August 6, 1999 Order. For convenience, a copy of that Order is attached hereto as Exhibit B.

According to the 1999 Florida Order, all matters in the Florida Case were stayed pending resolution of American Auto Accessories, Inc. and Keen Tools Corp. v. Winner International Corp., No. CV 96-5738 (NG), which at that time was pending in the Eastern District of New York. Exhibit B at 3. The Florida Order provides that the parties:

**shall** inform the Court of the disposition of the American Auto Accessories, Inc. action ***no later than ten (10) days after judgment is entered, at which point*** the parties may also petition the Court to reopen the instant case.

Exhibit B at 3 (emphasis added).

According to the docket in American Auto Accessories, a copy of which is attached hereto as Exhibit C, that case was dismissed on November 14, 2001 for lack of progress, and was closed on the same date.

Thus, Defendant had ten days—until **November 24, 2001**—to reopen the Florida Case. Defendant did not. Defendant did not comply with any of the requirements of the Florida Order. It did not inform the Florida court of the disposition of the American Auto Accessories case, and it did not petition the Florida court to reopen the Florida Case within ten days after that case was resolved. The Florida case remains closed and cannot be reopened.

The closed Florida case has no bearing on Plaintiff's standing in this case, and does not provide any grounds for dismissal of this case. Even if the Florida case could be reopened, transfer of this case to Florida would not be proper under 28 U.S.C. § 1404(a). A plaintiff's choice of venue should not be lightly disturbed. Jumara v. State Farm Ins. Co., 55 F.3d 873, 879 (3d Cir. 1995). None of the § 1404(a) factors favors or mandates transfer; the parties are located in Pennsylvania, the witnesses are located in Pennsylvania and Taiwan, and the interests of

justice favor retaining this case in Pennsylvania. Florida has nothing to do with this case, and Defendant's threat to reopen a closed case and transfer this case should be viewed as nothing but a ploy to avoid litigating the merits of this case in this District. Any attempt to reopen and transfer the case would simply waste resources, for Plaintiff would intervene and move to transfer the case to the Eastern District of Pennsylvania, given that there is nothing and no one in Florida relevant to this case.

### **III. Defendant Concedes that Mr. Vito is Neither a Necessary Nor an Indispensable Party.**

Defendant has conceded the flaws in its Rule 19 joinder claim, for it ignores completely the procedural and substantive errors that Plaintiff pointed out with the Rule 19 claims.

Defendant has not established that Mr. Vito is a necessary party under Rule 19(a). Having failed to do so, Defendant cannot, as a matter of law, establish that Mr. Vito is a "necessary party" under Rule 19(b).<sup>3</sup> For all of the reasons stated in Plaintiff's Objection, there is no ground on which the Court need even consider applying Rule 19(b) to dismiss the case.

Plaintiff has submitted the necessary portions of its license with Mr. Vito establishing the transfer of all substantial rights to Plaintiff that confer standing as a matter of law under the Supreme Court's decision in Waterman v. Mackenzie, 138 U.S. 252, 255-56 (1981) and as applied subsequently. See, e.g., Hook v. Hook & Ackerman, Inc., 187 F.2d 52, 58 (3d Cir. 1951). However, if for any reason the Court wishes to view the License in its entirety, Plaintiff will submit it to the Court for *in camera* inspection.

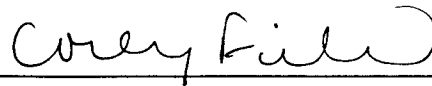
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<sup>3</sup> Defendant has also dropped entirely its claim that Keen Tools is an indispensable party.



#### IV. Conclusion

Plaintiff has established the unbroken chain of title from Mr. Yang, the inventor of the '621 design, to Mr. Vito, and Mr. Vito's transfer to Plaintiff of all substantial rights in the patent. Plaintiff has also established that Mr. Vito and Keen Tools are not necessary parties to the suit, and that it has the right to maintain this action in its sole name and have the case remain in Pennsylvania. Accordingly, Defendant's Motion to Dismiss must be denied and this case allowed to proceed.



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Attorneys for Plaintiff  
Lawman Armor Corporation

Dated: September 26, 2002

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

LAWMAN ARMOR CORP.,

Plaintiff,

v.

WINNER INTERNATIONAL, LLC.

Defendant.

CIVIL ACTION NO. 02-4595

Hon. Robert F. Kelly

SUPPLEMENTAL DECLARATION OF PAUL YANG

1. I am the inventor of United States Design Patent No. Des. 357,621 (the "621 Patent") at issue in this case.

2. I made a Declaration in this matter dated September 12, 2002. I hereby make the following Supplemental Declaration.

3. Effective as of April 25, 1995 I assigned all of my interests in the '621 Patent to Keen Tools Corporation, a corporation of the People's Republic of China.

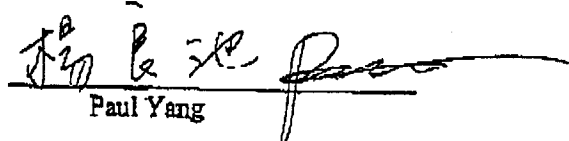
4. On May 5, 2000, Keen Tools Corporation assigned all of its interests in the '621 Patent back to me in my individual capacity. As President of Keen Tools Corporation, I executed the Assignment document on May 5, 2000. May 5, 2000 was also the effective date of the Assignment. A true and correct copy of the Assignment document was attached to my prior Declaration as Exhibit 1, and for convenience is also attached to this Supplemental Declaration as Exhibit 1.

5. On June 4, 2002, I assigned all of my interests in the '621 Patent to Robert A. Vito, and confirmed that assignment on June 28, 2002. A true and correct copy of the June 4, 2002 Assignment is attached to this Supplemental Declaration as Exhibit 2.

6. The statement in the June 4, 2002 Assignment referring to "uncertainty" was included out of an abundance of caution and not because of any specific uncertainty concerning the May 5, 2000 Assignment from Keen Tools Corporation to myself.

I declare under penalty of perjury that the foregoing statements are true and correct.

Executed on 26, Sept, 2002

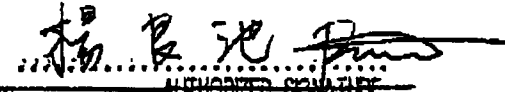
  
Paul Yang

**ASSIGNMENT OF PATENT**

KEEN TOOLS CORPORATION, a Taiwanese Corporation, in consideration of the sum of One Dollar (US\$1.00) and other good and valuable consideration paid, the receipt and sufficiency of which is hereby acknowledged, assigns, transfers and sets over to Paul Yang, his successors and assigns, the entire right, title and interest, including all claims relating thereto, for the United States and its territories, dependencies and possessions, in and to United States Design Patent No DES 357,621, and any reissue, substitute or extension, which may issue there from. This Assignment of Patent shall be deemed effective as of 5<sup>th</sup> May 2000. This assignment specifically includes assignment of the right to sue for all past infringements of United States Design Patent No DES 357,621.

**KEEN TOOLS CORPORATION**KEEN TOOLS CORPORATION

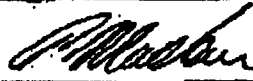
By



AUTHORIZED SIGNATURE

Paul Yang, President.

Witness

Paul Moreton.

**ASSIGNMENT**

WHEREAS, I, Paul Yang, 49-1, Feng Hwa, Feng Hwa Tsoen, Shih Shyh Hsiang, Tainan Hsiao, Taiwan R.O.C., (hereinafter generally referred to as "ASSIGNOR"), have invented a certain new and useful:

**SLIDING HOOK PORTION OF A VEHICLE  
STEERING WHEEL LOCK ASSEMBLY**

for which I have received United States Letters Patent No. Des. 357,621; and all related Letter Patents that are issued in the territory of the United States and its possessions and territories; Mexico; and Canada.

WHEREAS, Robert A. Vito, an individual residing at 1434 Sugartown Road, Berwyn, PA 19312, hereinafter generally referred to as "ASSIGNEE", is desirous of acquiring said invention and said patents; and

WHEREAS, ASSIGNOR has expressed concern about their ability to enter into this Assignment based upon uncertainty with respect to the rights possessed by ASSIGNOR, but is willing to transfer to ASSIGNEE whatever rights are possessed by ASSIGNOR.

NOW, THEREFORE, in consideration of the sum of Five Thousand Dollars (\$5,000.00) and other good and valuable executed consideration, the full receipt and sufficiency of all of which are hereby acknowledged, and intending to be legally bound hereby, the ASSIGNOR, hereby agrees to sell, assign, transfer and convey and by these presents does sell, assign, transfer and convey unto the above-named ASSIGNEE, the whole and entire right, title and interest

in and to said inventions and Letters Patents for the territory of the United States and its possessions and territories; and

in and to said inventions and Letters Patents for the territory of the Mexico and its possessions and territories; and


in and to said inventions and Letters Patents for the territory of the Canada and its possessions and territories; and

in and to the above Letters Patents, all of the Letter Patents for the United States and its possessions and territories which may be granted on said inventions including divisions, reissues, reexamination certificates and continuations; and


together with all claims for damages by reason of past infringement of said United States Letters Patents with the right to sue for and collect the same for its own use and behalf or for the use and behalf of its legal representatives;

said inventions and Letters Patents to be held and enjoyed by the above-named ASSIGNEE, for ASSIGNEE's own use and behalf, and for ASSIGNEE's legal representatives and assigns to the full end of the term or terms for which said Letters Patents have been granted, as fully and entirely as the same would have been held by the undersigned ASSIGNOR had this assignment and sale not been made; and for the aforesaid consideration ASSIGNOR hereby covenants, agrees and undertakes to execute, whenever requested by the above-named ASSIGNEE, all patent applications, assignments, lawful oaths and any other papers which ASSIGNEE may deem necessary or desirable for securing to ASSIGNEE or for maintaining for ASSIGNEE all the Letters Patents hereby assigned or agreed to be assigned; all without further compensation to the undersigned ASSIGNOR.

4 June 02.  
(Date)

  
Paul Yang (Seal)

WITNESS:

  
Signature  
Paul MORSTON  
Name  
PO Box 1141  
Address  
TAIWAN CITY TAIWAN  
Address

2 of 2

RECORDED: 06/06/2002

PATENT  
REEL: 012775 FRAME: 0044

UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF FLORIDA  
MIAMI DIVISION

Case No. 99-552-CIV-MOORE

KEEN TOOLS CORPORATION,

Plaintiff,

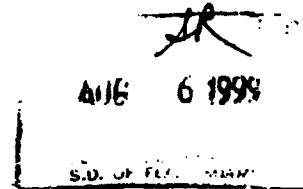
vs.

WINNER INTERNATIONAL, INC.,  
a Pennsylvania Trust; and WINNER  
INTERNATIONAL ROYALTY  
CORPORATION,

Defendants.

ORDER

**CLOSED  
CIVIL  
CASE**



THIS CAUSE came before the Court sua sponte.

UPON CONSIDERATION of the Motion and response, and being otherwise fully advised in the premises, the Court enters the following ORDER.

**BACKGROUND**

This is an action by a Taiwanese manufacturer and distributor of automotive accessories, Keen Tools Corporation ("Keen"), against the manufacturer of a vehicle anti-theft device, Winner International LLC ("Winner"), for patent infringement, trade dress infringement, and unfair competition.

Since 1986, Winner has been manufacturing, marketing, and selling a vehicle anti-theft device entitled "the Club." Winner alleges that this device is protected by a number of patents, a trademark, and an inherently distinctive trade dress.

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P2D

At some point after the development and sale of the Club, Keen obtained a patent (the "'621 Patent"), in order to develop and sell a vehicle anti-theft device with a dual hook design. Under this patent, Keen has marketed and sold a product that it has labeled and sold under the names "Dr. Hook," and "Elephant Lock."

Following the development and sale of Dr. Hook/Elephant Lock, Keen brought an action against Winner for declaratory relief. Specifically, Keen sought a judicial determination that Dr. Hook/Elephant Lock did not infringe the patents which Winner held to protect its interests in the manufacture and sale of the Club. That case is currently pending in the Eastern District of New York. See American Auto Accessories, Inc. and Keen Tools Corp. v. Winner Int'l Corp., No. CV 96-5738 (NG) (the "New York action").

At some point following the development of Dr. Hooks/Elephant Lock, Winner began marketing an "off brand" vehicle anti-theft device entitled "Double Hooks." Keen now claims that Double Hooks directly infringes the '621 Patent.

In its Answer, Winner requests, inter alia, that the Court enter an order staying the instant case pending the outcome of the New York action.

### DISCUSSION

In both the instant action and the New York action, there are common issues of fact, as well as common questions of patent validity. These issues raise significant concerns over whether the interests of judicial economy are best served by the current scheme of dual-jurisdiction adjudication of the two pending cases. Further, it appears to the Court that should the New York action result in a decision adverse to Keen, the instant action would become moot. Accordingly, the Court issued an Order on June 30, 1999, requiring the parties to show cause why the above-

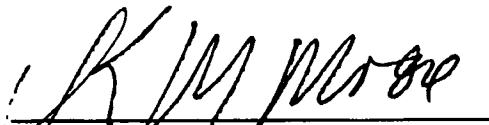
captioned action should not be stayed or transferred. On July 16, 1999, Defendant Winner filed a memorandum of law in support of staying the case. To date, no response has been filed by Plaintiff.

### CONCLUSION

UPON CONSIDERATION of the record, it is hereby ORDERED AND ADJUDGED that this case is CLOSED FOR STATISTICAL PURPOSES.

All matters in this action are stayed pending resolution of the case of American Auto Accessories, Inc. and Keen Tools Corp. v. Winner International Corp., No. CV 96-5738 (NG), which is currently pending in the United States District Court for the Eastern District of New York. The parties shall inform the Court of the disposition of the American Auto Accessories, Inc. action no later than ten (10) days after judgment is entered, at which point the parties may also petition the Court to reopen the instant case (Case No. 99-552-CIV-MOORE).

DONE AND ORDERED in Chambers at Miami, Florida, this 6th day of August, 1999.

  
\_\_\_\_\_  
MICHAEL MOORE  
UNITED STATES DISTRICT JUDGE

cc: Stephen M. Gaffigan, Esq.  
Silvia M. Garrigo, Esq.



Docket as of November 14, 2001 7:54 pm

Web PACER (v2.4)

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**U.S. District Court**

**New York Eastern (Brooklyn)**

**CIVIL DOCKET FOR CASE #: 96-CV-5738**

**American Auto Access, et al v. Winner International**

Filed: 11/22/96  
Assigned to: Judge Nina Gershon  
Demand: \$0,000  
Nature of Suit: 830  
Lead Docket: None  
Jurisdiction: Federal Question  
Dkt# in other court: None  
Cause: 28:2201 Declaratory Judgment

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AMERICAN AUTO ACCESSORIES INC.,  
a New York Corporation  
plaintiff

George R. Hinckley, Jr.  
[term 02/14/00]  
Below Address Terminated on 2/18/00  
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[COR LD NTC]

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Miami, FL 33131  
(305) 379-3428

v.

WINNER INTERNATIONAL CORP., a  
Pennsylvania Business Trust  
defendant

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Kenneth A. Lapatine  
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(212) 977-6600

-----  
WINNER INTERNATIONAL CORP.  
counter-claimant

Adam David Cole  
(See above)  
[COR LD NTC]

Kenneth A. Lapatine  
(See above)  
[COR LD NTC]

v.

AMERICAN AUTO ACCESSORIES INC.  
counter-defendant

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Michael C. Cesarano, Esq.  
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KEEN TOOLS CORPORATION  
counter-defendant

Thomas A. Smart  
(See above)  
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Steven Ira Peretz  
(See above)  
[COR LD NTC]

Stephen Michael Gaffigan  
[term 03/21/00]  
[COR LD NTC]  
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201 South Biscayne Boulevard  
17th Floor, Miami Center

Miami, Fl 33131  
(305) 379-3428

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## DOCKET PROCEEDINGS

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DATE	#	DOCKET ENTRY
11/22/96	1	COMPLAINT filed and summons(es) issued for Winner International FILING FEE \$ 120.00 RECEIPT # 189364 (ml) [Entry date 12/04/96]
12/16/96	2	STIP/ORDER dated 12/17/96 that deft Winner International's time to answer or move extended to & including 1/15/97. (signed by Judge Nina Gershon). (lg) [Entry date 12/19/96]
12/23/96	3	RETURN OF SERVICE executed as to Winner International Corp. 11/25/96 Answer due on 12/15/96 for Winner International Corp. (ll) [Entry date 12/24/96]
1/17/97	4	LETTER dated 1/13/97 from Adam Cole to Messrs. Smart and Peretz, enclosing copies of Winner International's Notice of Motion to Dismiss along with Winner International's Memo of Law in support of Motion to Dismiss and Winner International's Rule 9 Statment. (Without enclosure) (ll) [Entry date 01/17/97]
1/29/97	5	LETTER dated 1/27/97 from Adam D. Cole to Judge Gershon, informing that deft. Winner has agreed to plttf.'s request for an extension of time to respond to Winner's motion to dismiss (returnable 1/28/97) to 2/11/97. Winner's reply, if any, will be due on 2/18/97 and the return date scheduled for 2/20/97. (ll) [Entry date 01/29/97]
2/19/97	6	LETTER dated 2/18/97 from Adam Cole to Judge Gershon, advising that deft. Winner has agreed to plttfs.' further request for an extension of time to respond to Winner's motion to dismiss, returnable 1/28/97 to 2/25/97. Winner's reply, if any, will be due on 3/4/97, and the return date scheudled for 3/6/97. (ll) [Entry date 02/19/97]
3/3/97	7	LETTER dated 3/3/97 from Adam Cole to Judge Gershon informing that deft. Winner has agreed to plttfs.' request for an extension of time to respond to Winner's motion to dismiss, originally returnable 1/28/97, to 3/17/97. Winner's reply, if any, will be due on 3/24/97, and the return date scheduled for 3/26/97. (ll) [Entry date 03/05/97]

3/12/97 8 MOTION by American Auto Accessories, Inc., Keen Tools Corp. for Steven Ira Peretz, Stephen Michael Gaffigan to appear pro hac vice. (11) [Entry date 03/13/97]

3/18/97 -- Endorsed order dated 3/17/97, granting [8-1] motion for Steven Ira Peretz, Stephen Michael Gaffigan to appear pro hac vice for plttfs. ( Signed by Judge Nina Gershon on reverse of document #8 ) C/M (11) [Entry date 03/18/97]

3/19/97 9 LETTER dated 3/17/97 from David Raskin to Judge Gershon, advising that deft. will not oppose plttfs' motion for admissions pro hac vice filed on 3/12/97. (11) [Entry date 03/19/97]

3/31/97 10 FIRST AMENDED COMPLAINT by American Auto Accessories, Inc., Keen Tools Corp. , (Answer due 4/10/97 for Winner International Corp. ) amending [1-1] complaint. (11) [Entry date 03/31/97]

4/2/97 11 LETTER dated 3/26/97 from Adam Cole to Judge Gershon, advising that deft. Winner has agreed to plttfs' request for an extension of time to respond to Winner's motion to dismiss, originally returnable 1/28/97, to 4/8/97. Winner's reply, if any, will be due on 4/22/97, and the return date scheduled for 4/24/97. (11) [Entry date 04/02/97]

6/18/97 12 LETTER dated 6/17/97 from Adam D. Cole to Judge Gershon, informing that deft. Winner withdraws its motion to dismiss plttff.'s initial complaint. (11) [Entry date 06/18/97]

6/18/97 13 STIP/ORDER (not dated) that time for deft. Winner International Corp. to answer the amended complaint is extended to 7/8/97 ( signed by Judge Nina Gershon ) (11) [Entry date 06/18/97]

7/23/97 14 ORDER dated 7/22/97 that an initial conference will be held on 9/17/97 at 4:00 p.m. before Magistrate Roanne L. Mann C/M ( signed by Magistrate Roanne L. Mann ) (11) [Entry date 07/23/97]

9/17/97 15 Calendar entry: Before Mag. Mann on 9/17/97 at 4:00 p.m., case called for initial conferernce. Fact discovery to be completed by 7/31/98. Next settlement conference scheduled for 3:30 8/6/98 before Magistrate Roanne L. Mann. Automatic disclosure shall be completed by 10/31/97. Pleadings may be amended and new parties joined as of right under 3/2/98. (11) [Entry date 09/18/97]

9/25/97 16 NOTICE of Change of Address by the law firm of Kluger, Peretz, Kaplan & Berlin, P.A. (11) [Entry date 09/26/97]

12/29/97 17 NOTICE by American Auto Access and Keen Tools Corp. to take deposition of Winner International Corp. on 1/23/98 at 9:00. (tdh) [Entry date 12/29/97]

1/5/98 18 STIPULATION AND ORDER, staying proceedings in this case pending entry of final judgment in the 146 Action or other disposition through settlement. ( signed by Magistrate Roanne L. Mann on 1/9/98.) (md) [Entry date 01/26/98]

1/14/98 -- CASE NO LONGER REFERRED TO Magistrate Roanne L. Mann as case should be administratively closed. (mp) [Entry date 01/14/98]

1/16/98 -- CASE REFERRED to Magistrate Roanne L. Mann (mp) [Entry date 01/16/98]

1/16/98 -- Magistrate Judge Mann has been selected by random selection to handle any matters that may be referred in this case. (md) [Entry date 01/16/98]

3/16/98 19 STIPULATION AND ORDER, resetting answer due for 20 days after the expiration of the Stipulation and ORder of Stay dated 12/28/97. ( signed by Magistrate Roanne L. Mann (undated). (md) [Entry date 03/16/98]

3/31/98 21 NOTICE of plaintiffs' unavailability of counsel, Stephen Gaffigan, of Kluger, Peretz, Kaplan & Berlin during the moth of August 1998., (wa) [Entry date 05/07/98]

4/6/98 20 ORDER dtd. 3/24/98 The stip. was so ordered & docketed in Jan. 1998. On ltr. dtd. 3/23/98 from Adam D.Cole regarding stip. and order of stay of discovery schedule. ( signed by Magistrate Roanne L. Mann ) (rj) [Entry date 04/06/98]

10/13/98 22 LETTER dated 10/7/98 from Adam D. Cole, Esq. to Magistrate Mann requesting that the Court schedule a conference at it's earliest convenience to set a new discovery schedule. (clp) [Entry date 10/13/98]

10/14/98 23 ORDER dated 10/9/98 directing that defendant shall show cause in writing by 10/16/98, why the stay in this action should not be extended until the decision of the Federal Circuit on the validity of the Winner Patent. Plaintiff may reply by 10/22/98. (The parties shall provide the Court with the dates for briefing and oral argumnet in the Federal District). Signed by Magistrate Roanne L. Mann. See faxed copy of letter dated 10/7/98 from Stephen M. Gaffigan, Esq. to Magistrate Mann. (clp) [Entry date 10/14/98]

2/18/99 24 MEMORANDUM and ORDER dated 2/16/99 directing that for the reasons stated in this document, this Court denies plaintiffs' application to extend the stay of this case. The parties shall confer and, by February 24, 1999, submit a joint proposed discovery schedule. Signed by Magistrate Roanne L. Mann. Faxed by chambers. ) (clp) [Entry date 02/18/99]

3/4/99 25 ORDER dated 3/1/99 granting the plaintiff's request for an enlargement of time up to and including 3/3/99 to submit a joint proposed discovery schedule. Signed by Magistrate Roanne L. Mann. See faxed copy of letter dated 3/26/99 from Stephen M. Gaffigan, Esq. to Mag. Mann. (clp) [Entry date 03/04/99]

3/9/99 26 ANSWER by Winner International Corp. to the first amended complaint and COUNTERCLAIMS. (sg) [Entry date 03/12/99]

3/9/99 -- COUNTERCLAIM by Winner International against Keen Tools

Corp. and American Auto Accessories, Inc. (See doc. #26)  
(sg) [Entry date 03/12/99]

- 3/23/99 27 STIPULATED DISCOVERY PLAND AND SCHEDULING ORDER setting initial disclosures to be completed by 3/15/99; expert discovery to be completed by 10/8/99 which may be extended provided they do not extend beyond the settlement conference set for 10/13/99 at 10:00 and further provided that the parties promptly notify the Court of the modification; pleadings may be amended and new parties joined as of right until 4/30/99; dispositive motions to be filed by 11/12/99. \*\* refer to document for further deadlines \*\* Signed by Magistrate Roanne L. Mann on 3/5/99. (c/f by chambers on 3/8/99) (wa) [Entry date 03/23/99]
- 3/23/99 28 ANSWER by Keen Tools Corp., American Auto Access to [0-1] counter claim. (clp) [Entry date 03/25/99]
- 3/26/99 29 Plaintiffs' Notice of Serving Amended First Set of Interrogatories to defendant, Winner International, L.L.C. (clp) [Entry date 03/31/99]
- 4/29/99 30 NOTICE of filing Amended Pleadings in accordance with scheduling order by Keen Tools Corp.and American Auto Access. (clp) [Entry date 05/05/99]
- 4/29/99 31 SECOND AMENDED COMPLAINT by Keen Tools Corp., American Auto Access. Answer due 5/9/99 for Winner International. Amending [10-1] amended complaint. (clp) [Entry date 05/05/99]
- 6/29/99 32 MEMORANDUM by Defendants in opposition to stay of proceedings. (clp) [Entry date 06/29/99]
- 6/29/99 33 DECLARATION of Adam D. Cole, Esq. on behalf of the defts. requesting plaintiffs motion to stay. (clp) [Entry date 06/29/99]
- 8/11/99 34 NOTICE of Absence from Jurisdiction filed by Steven I. Peretz, Esq., counsel for the Plaintiffs. Counsel will be absent from jurisdiction from 10/1/99 -10/15/99. (clp) [Entry date 08/18/99]
- 9/10/99 35 ORDER directing as follows; the parties' request for a 120 day extension of the discovery and other deadlines set forth in the 3/99 discovery plan and scheduling order is granted. Thus Fact discovery shall be completed by 12/28/99; expert discovery sall be completed by 2/5/00. The settlement conference is adjourned to 2/8/00 at 2:00. In view of the lenght of the extension, no further adjournments will be granted. Signed by Magistrate-Judge Roanne L. Mann , on 9/7/99. See letter dated 9/3/99 from Adam D. Cole, Esq. to Mag. Mann. (clp) [Entry date 09/10/99]
- 11/2/99 36 LETTER sent to docketing dated 10/27/99 from Adam D. Cole, Esq. to Judge Gershon requesting that the Court order a date certain for replacement counsel for the pltf. to be appointed. (clp) [Entry date 11/02/99]
- 12/16/99 37 LETTER sent to docketing dated 10/26/99 from Stephen M.

Gaffigan, Esq. to Judge Gershon requesting permission to withdraw as counsel for the plaintiffs. (clp)  
[Entry date 12/16/99]

- 1/18/00 38 LETTER sent to docketing dated 1/7/00 from Adam D. Cole, Esq. to Judges Gershon and Mann written on behalf of Winner International to request a pre-motion conference. (clp)  
[Entry date 01/18/00]
- 1/24/00 39 ORDER: The Court has learned that a pre-motion conference is scheduled before Judge Gershon for 2/8/00. In View of this development. and the fact that discovery reportedly has not been completed, the 2/8/00 settlement conference is adjourned sine die. The parties are directed to submit a status report to Mag. Mann's chambers by 2/16/00. Signed by Magistrate Roanne L. Mann , on 1/19/00. ( See letter dated 1/7/00 from Adam D. Cole, Esq. to Judge Gershon and Mag. Mann. (clp) [Entry date 01/24/00]
- 2/8/00 40 Calendar entry:Before Judge Gershon Civil Cause for pre motion conf. Bienstock & Clark will be substituted as counsel for plttf. Keen Tools, which has not yet appointed new counsel to replace Stephen Gaffigan, must appear by sub, counsel within 20 days. If it does not appear by sub, counsel, its claims will be dismissed and it will be subject to default on deft's counterclaims. During the next 20 days, Mr Gaffigan is directed to remain in the case for the sole purpose of transmitting copies of any court orders to Keen Tools. Mr Gaffigan is also directed to transmit a copy of the transcript of this conf. to American Auto, Keen Tools and Mag Mann. Deft's motion to dismiss on the ground that plttf's have failed to comply with discovery is referred to Mag Mann. (rj)  
[Entry date 02/10/00]
- 2/14/00 41 STIPULATION and ORDER, substituting attorney; terminated attorney George R. Hinckley for American Auto Access. Added attorney Michael C. Cesarano. Signed by Judge Nina Gershon , on 2/8/00. (clp) [Entry date 02/14/00]
- 2/17/00 42 LETTER sent to docketing dated 2/9/00 from George R. Hinckley, Jr. Esq. to Judge Gershon enclosing a stipulation for substitution of counsel to be so ordered by the Court. (Stip attached unsigned by Judge Gershon) (clp)  
[Entry date 02/17/00]
- 3/3/00 43 ORDER: The parties shall on pain of sanctions submit a status report to chambers by 3/3/00. Signed by Magistrate Roanne L. Mann , on 2/24/00. (clp) [Entry date 03/03/00]
- 3/3/00 44 NOTICE of attorney appearance for Keen Tools Corp. by Mark J. Abate. (clp) [Entry date 03/03/00]
- 3/21/00 45 LETTER dated 2/28/00 from Stephen Gaffigan, Esq., to Magistrate Mann, stating that his firm now represents Keen Tools Corp. and were relieved as counsel for American Auto Access. before Judge Gershon on 2/8/00. (wa)  
[Entry date 03/21/00]
- 3/21/00 46 LETTER dated 3/2/00 from Adam Cole, counsel for Winner



International LLC, to Magistrate Mann, stating that since now counsel has be replaced for plaintiffs, discovery will now proceed and is requesting a discovery cut off date be set for 5/1/00. (wa) [Entry date 03/21/00]

- 3/21/00 47 LETTER dated 3/2/00 from Michael Cesarano, new counsel for American Auto Access., to Magistrate Mann, requesting to have the discovery cut off date extended until 6/1/00. (wa) [Entry date 03/21/00]
- 3/21/00 48 LETTER dated 3/3/00 from Mark Abate, counsel for Keen Tools Corp., to Magistrate Mann, forwarding a proposed revised discovery plan and scheduling order. (wa) [Entry date 03/21/00] [Edit date 03/21/00]
- 3/21/00 49 LETTER dated 3/8/00 from Adam Cole, counsel for Winner International, to Magistrate Mann, in opposition to Kenn Tools' request for a six month extension of the discovery schedule. (wa) [Entry date 03/21/00]
- 3/21/00 50 LETTER dated 3/3/00 from George Hinckley, local counsel for American Auto Access., to Magistrate Mann, forwarding a letter from principal counsel, Michael Cesarano whose pro hac vice motin will be filed shortly. (wa) [Entry date 03/21/00]
- 3/21/00 51 ORDER that all fact discovery, including depositions, shall be completed by 5/15/00. Expert disclosures to be made by 6/2/00; experts whose testimony is intended to contradict or rebut expert testimony shall be made by 6/20/00; trial to be held in November 2000, either before Judge Gershon or before a visitng Judge. Schedule for briefing of motions to be set by trial judge, unless otherwise directed. Updated status report due 4/21/00. Signed by Magistrate Roanne L. Mann on 3/17/00. {c/f on 3/17/00} (wa) [Entry date 03/21/00]
- 3/23/00 52 NOTICE: The Hon. Avern Cohn, U.S.D.J, will be sitting by designation from 4/3/00 until 4/14/00. This case has been referred to Judge Cohn for trial or dispostion. A status conference will be held on 4/4/00 at 4:00. (clp) [Entry date 03/23/00]
- 3/23/00 53 CALENDAR NOTICE: This matter is set for a Status Conf. be fore Judge Avern Cohn on 4/4/00 at 4:00 in room 546. (clp) [Entry date 03/23/00]
- 3/24/00 54 LETTER sent to docketing (undated) from Chambers of Judge Gershon to counsel for the parties advising that this case has been referred to Visiting Judge Avern Cohn for trial durring November of this year. Judge Cohn's chambers will contact the parties in order to set a more detailed schedule. (clp) [Entry date 03/24/00]
- 3/29/00 55 LETTER dated 3/28/00 from Mark J. Abate, Esq. to Mag. Mann requesting assistance in resolving a discovery dispute. (clp) [Entry date 03/29/00]
- 4/4/00 56 Calendar entry: Case called on 4/4/00 for Status Conf. before Judge Avern Conh. Counsel for all sides present. Conf. held. RULINGS: Parties are advised to file various

papers with the Court. Infringement case to be tried first. The Court will send packages to all counsel containing the Court's procedures for patent cases and the Court's decision on his last two cases. Parties advised to write to the Court in Eastern District of Michigan for Judge Cohn. (clp) [Entry date 04/06/00]

- 4/14/00 57 LETTER sent to docketing dated 3/31/00 from Adam D. Cole, Esq. to Mag. Mann written on behalf of deft. Winner International in response to the letter submitted by pltf.'s counsel dated 3/28/00. (clp) [Entry date 04/14/00]
- 5/1/00 58 ORDER setting forth the issues to be addressed at the trial of this matter. A separate pre-trial order setting forth the following dates is attached; Discovery shall be completed by 5/30/00; Pre Trial Order: Pltf: 9/25/00; Deft: 10/16/00; Joint: 10/30/00; Pre-Trial Conference scheduled for 11/6/00 at 9:00. Trial shall commence on 11/7/00 at 9:00. Signed by Visiting Judge VJ Avern Cohn, on 4/28/00. (clp) [Entry date 05/01/00] [Edit date 05/01/00]
- 5/9/00 59 ORDER (unsigned copy) of Visiting Judge directing as follows; The time for completing fact discovery is extended to 7/14/00; Open expert reports are due 8/1/00; rebuttal expert reports are due on 8/15/00; expert depositions are to be completed by 8/30/00. The Deft.'s Markman hearing shall be made on 9/15/00. The 11/7/00 trial and related discovery are limited to the issues of infringement, res judicata and equitable estoppel. (clp) [Entry date 05/15/00]
- 5/9/00 60 NOTICE of Joint Motion to Extend Discovery. (clp) [Entry date 05/15/00]
- 5/15/00 61 ORDER; signed by Visiting Judge Avern Cohn on 5/12/00; directing as follows; The time for completing fact discovery is extended to 7/14/00; Open expert reports are due 8/1/00; rebuttal expert reports are due on 8/15/00; expert depositions are to be completed by 8/30/00. The Deft.'s Markman hearing shall be completed by 8/30/00. The Deft.'s Markman hearing shall be made on 9/15/00. The 11/7/00 trial and related discovery are limited to the issues of infringement, res judicata and equitable estoppel. (clp) [Entry date 05/16/00]
- 5/17/00 62 LETTER dated 5/17/00 from Mark J. Abate, Esq. to Judge Avern Cohn requesting the Court's assistance in resolving several discovery disputes concerning Winner International's responses to Keen's interrogatories. (clp) [Entry date 05/18/00]
- 6/9/00 63 NOTICE of Change of Address by George R. Hinckley, Jr. attorney American Auto Access. New address: Traiger & Hinkley LLP 880 Third Avenue, NY, NY 10022-4730. (212)759-4933; Fax: (212) 656-1531. (clp) [Entry date 06/13/00]
- 6/9/00 64 MOTION as to Keen Tools Corp. for Mark J. Abate to withdraw as attorney for Keen Tools Corp. Motion file stamped: 6/9/00 and mailed/served: 6/9/00. (clp)

[Entry date 06/16/00]

6/13/00 65 OBJECTIONS AND RESPONSES by Kluger, Peretz, Kaplan & Berlin, P.A's to subpoena duces tecum of Winner International. (clp) [Entry date 06/16/00]

7/5/00 66 ORDER granting Mark J. Abate and Morgan & Finnegan's [64-1] motion for Mark J. Abate to withdraw as attorney for Keen Tools Corp. (Terminated attorney Mark J. Abate for Keen Tools Corp.) Keen has 20 days from the date of this Order to have an appearance entered by as newly retained counsel Keen has 30 days from the date of this Order to make its witnesses available for their depositions. Signed by Visiting Judge VJ Avern Cohn , on 6/28/00. (clp) [Entry date 07/05/00]

7/6/00 67 LETTER dated 7/6/00 from Mark J. Abate, Esq. to Clerk of the Court enclosing a copy of the Court's 6/28/00 Order with Certificate of Service on Keen Tools Corp. (Encls. attached to this doc) (clp) [Entry date 07/13/00]

8/4/00 68 MOTION by Winner International for default and contempt judgment and against Keen Tools Corp.. Motion file stamped: 8/15/00 and mailed/served: 8/4/00. (clp) [Entry date 08/25/00]

8/28/00 69 NOTICE of change of address as counsel for American Auto Accessories: Michael C. Cesarano, Adam D.Cole, Esq., Camhy Karlinsky & Stein LLP, 1740 Broadway, 16th New York, N.Y. 10019-4315. (ld) [Entry date 08/28/00]

8/31/00 70 ORDER, INJUNCTION and JUDGMENT: A default Judgment in entered against pltf. and counter-deft. Keen Tools Corp. on the motion of dft. and counter pltf. Winner International Corp; and: A. The Second Amended Complaint is dismissed as to Keen only; B. Keen is adjudged to have infringed on U.S. Patent Nos. 4,935,047('047 patent) and 5,865,044(044 pantent). See this document for injunctions and enjoiments against Keen. Signed by VJ, Avern Cohn , on 8/29/00. c/m by chambers. (clp) [Entry date 09/05/00]

10/31/00 -- CASE NO LONGER REFERRED TO Magistrate Roanne L. Mann (mp) [Entry date 11/01/00]

11/14/01 71 ORDER, dismissing case for lack of progress. C/M by chambers. ( signed by VJ, Avern Cohn , on 11/7/01) (chee) [Entry date 11/14/01]

11/14/01 -- Case closed as per document #71. (chee) [Entry date 11/14/01]

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Case Flags:  
CLOSED

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Billable Pages:	13	Cost:	0.91

**CERTIFICATE OF SERVICE**

I hereby certify that copies of the foregoing Motion For Leave To File Sur-Reply  
Opposing Defendant's Motion to Dismiss, and Plaintiff Lawman Armor Corp.'s Sur-Reply  
Opposing Defendant's Motion to Dismiss were served on the following individuals on this date,  
as set forth below:

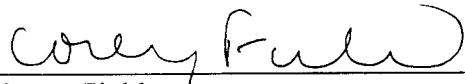
**VIA HAND DELIVERY**

Christopher A Rothe  
Dann Dorfman Herrell and Skillman, P.C  
Suite 720, 1601 Market Street  
Philadelphia, PA 19103

**VIA OVERNIGHT MAIL**

Robert V. Vickers  
Fay , Sharpe, Fagan, Minnich, & Mkenn LLP  
1100 Superior Avenue, Seventh Floor  
Cleveland, OH 44114

Dated: September 26, 2002

  
Corey Field